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OFFICE OF PETITIONS

In re Application of :
Olarig and Cook :
Application No. 10/390,010 : DECISION REFUSING STATUS
Filed: 31 December, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. H052617.1129US0:

This is in response to the petition filed under 37 CFR 1.47(a) on 10 September, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 31 December, 2001, without an executed oath or declaration. Accordingly, on 8 February, 2002, Initial Patent Examination Division mailed a "Notice to File Missing Parts of Nonprovisional Application" requiring an executed oath or declaration, and a surcharge for its late filing.

In response, on 8 July, 2002, petitioners a declaration naming Sompong Paul Olarig and Pamela M. Cook as joint inventors and signed by joint inventor Olarig and a three (3) month time extension. Accordingly, on 5 July, 2002, Initial Patent Examination Division mailed a Notice of Incomplete Nonprovisional Application, stating that joint inventor Cook's signature was necessary on the declaration.

In response, the present petition was filed on 10 September, 2002 (certificate of mailing date 9 September, 2002),¹ accompanied by a two (2) month extension of time. Petitioners assert that they have been unable to reach the non-signing inventors.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1), (2), and (5).

In regards to item (1), above, petitioners have not provided sufficient proof that a copy of the application (specification, including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor for review.² Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventor at the last known address or details in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers.³ If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

¹As 8 September, 2002, fell on a Sunday, the response filed with a certificate of mailing dated 9 September, 2002, is considered timely filed. 37 CFR 1.7(a).

²MPEP 409.03(d).

³Id.

In the event that the application papers are returned as undeliverable, petitioners may show diligent efforts to locate the non-signing inventor by providing a copy of an envelope showing that a letter sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details. Additionally, if any inventor no longer lives at the last known address, petitioners may show diligent efforts by use of a national registry or other database to determine a current address for the non-signing inventor. If a more recent address is discovered, petitioners should send or give a copy of the application papers to the inventor at that address.

If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that despite diligent efforts, the inventor could not be reached.

Although petitioners filed a two (2) month extension of time on 10 September, 2002, a five (5) month extension of time was required for a timely reply to the Notice to File Missing Parts mailed on 8 February, 2002. Therefore, the three (3) month extension of time filed on 8 July, 2002, and the two (2) month extension of time filed on 10 September, 2002, have been credited to counsel's deposit account, and counsel's deposit account has instead been charged for a five (5) month extension of time. The difference of \$640.00 has been charged to counsel's deposit account, No. 16-2435.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

A handwritten signature in cursive script, appearing to read "D. Wood".

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy